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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/618,558	07/11/2003	Peter Gansen	64215-028 CIP	5170

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HUSCH & EPPENBERGER, LLC
401 MAIN STREET
SUITE 1400
PEORIA, IL 61602

EXAMINER

SERGEANT, RABON A

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 10/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/618,558

Applicant(s)

GANSEN ET AL.

Examiner

Rabon Sergeant

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/861,330.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

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1. It is requested that applicants update the status of the parent application within the Cross Reference to Related Applications section of the specification.
2. The prior art set forth on the PTO-892 was made of record during prosecution of the parent application.
3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Antecedence has not been found within the specification for claiming that the molecular weight of claim 11 is weight average molecular weight.
4. Claim 2 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicants have failed to adequately describe how the loss factor is determined. DIN 53426 and BMW specification 1933613.3 are foreign test standards and there is nothing on the record that equates these standards to American (i.e., ASTM) testing standards; therefore, applicants are required to supply the disclosed testing standards in English.

5. Claims 1-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The language, "coarse-grain", renders the claims indefinite, because the language is subjective. It is unclear what quantitative dimensions or physical properties are denoted by "coarse-grain".

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6. Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Within line 2 of claim 12, "has" should be "have". Furthermore, the species of the Markush group should not be recited in the alternative, since a group of species has been specifically recited.

7. Claims 3, 4, 17, and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear how "effective" is to further limit "diameter".

8. Claims 1-18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicants have failed to clearly define what they believe solid to mean. Applicants have stated that the particles are solid; therefore, one would have expected the particles to be solid throughout; however, applicants further specify that such materials as foam flakes and cork pieces are suitable solid particles, even though they clearly contain void spaces. The position is taken that the types and scope of particles cannot be clearly determined.

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schapel et al. ('834) in view of Ehrlich, Jr. ('702) and Fracalossi et al. ('221).

Schapel et al. disclose polyurethane gel compositions, suitable for use as pressure distributing elements, such as seat cushions, mattresses, and shoe components, wherein the gel composition corresponds to applicants' claimed gel matrix component. See abstract and columns 1-11. Patentees further disclose that the polymer may contain fillers. See column 7, lines 3+.

11. Though the primary reference discloses the use of fillers, Schapel et al. fail to specifically recite the use of coarse materials to form a composite. However, the use of materials considered to correspond to applicants' claimed coarse particles within a polyurethane matrix, to be used as shoe soles, cushions, and mattresses, was known at the time of invention. Ehrlich, Jr. discloses the attendant advantages of incorporating wood or cork particles within a polyurethane matrix, to be used as a shoe sole. See column 2, lines 37+. Fracalossi et al. disclose that such materials as

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particulate foam, cork, and sawdust are added to a polyurethane to improve its physical properties. See column 3. Fracalossi et al. further disclose that the materials may be used as cushions and mattresses. See abstract.

12. Therefore, the position is taken in view of the aforementioned teachings within the secondary references that it would have been obvious to incorporate "coarse" particulate materials into the composition of Schapel et al., so as to obtain materials having improved properties as compared to the properties of the non-particulate containing compositions.

13. The examiner has considered applicants' experimental data within the Data Table of the specification; however, the data is insufficient to overcome the prior art rejections. Firstly, the comparative examples are not representative of the closest available prior art, because the most relevant disclosure of the prior art is concerned with polyurethane gel containing filler materials. Applicants' comparative examples are not drawn to such compositions. Secondly, the example of the invention is not commensurate in scope with the claims. Applicants' inventive example utilizes a single particle species at a single concentration; however, applicants' claims are not limited in accordance with this showing.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (571) 272-1079.

R. Sergent
September 27, 2004


RABON SERGENT
PRIMARY EXAMINER